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EXAMINER

PARTON, KEVIN S

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/433,139

Applicant(s)

SAVAGE ET AL.

Examiner

Kevin Parton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,8 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,8 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4 and 15-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-5 and 8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Response to Amendment***

2. The amendment to the claims filed on 11/06/2002 does not comply with the requirements of 37 CFR 1.121(c) because the clean form version of the amended claims includes the term [self-service terminal] listed in brackets. The clean form version of the amended claims should not include markings to show the changes made. Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

(c) Claims.

(1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

## **DETAILED ACTION**

### ***Election/Restrictions***

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3. Newly amended/submitted claims 1-4, and 15-17 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the amended claim 1 is significantly different from the original claim. All other claims are dependent upon claim 1. More specifically, claim 1 of the original application, the invention is a self-service terminal system comprising:

- a. A digital port for enabling interchange of digital data between the terminal and a portable digital device having a corresponding matching port and presented by a customer.
- b. Digital data transfer means for transferring data between the port and a digital data network.

The specification does not require a particular portable digital device and focuses on a number of uses including the transmission of images from a digital camera to an individual's email address from the terminal.

The amended claim 1 teaches an automated teller machine (ATM) comprising:

- a. A digital port for enabling interchange of digital data between the ATM and a portable digital device having a corresponding matching port and presented by a customer.
- b. Digital data transfer means for transferring data between the port and a digital data network.
- c. A card reader module for identifying a financial account for a transaction.
- d. A cash dispensing module for dispensing cash from the financial account.

- e. Wherein the ATM transfers transaction information related to the transaction performed at the ATM to the portable digital device utilizing the digital data port.

This claim specifies a type of transaction and portable device that is significantly different from the original claim. It also requires that the automated teller machine be used which is in a different field of search from the originally claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-4, and 15-17 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Amended claims 5 and 8, and newly added claims 18 – 21 have been treated on their merits, see the rejection below.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 19 recites the limitation "the ATM transfers" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 5, upon which this is dependent, does not refer to an ATM, only a self-service terminal.

7. Claim 20 recites the limitation "the ATM receives" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 5, upon which this is dependent, does not refer to an ATM, only a self-service terminal.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Wang (USPN 6,282,656).

10. Regarding claim 5, Wang (USPN 6,282,656) teaches a self-service terminal comprising:

- a. A wireless digital data port for enabling interchange of digital data between the terminal and a portable digital data device having a corresponding matching port and presented by a customer (figure 2), said port transmitting and receiving financial transaction data on an infra-red carrier signal, the financial transaction data transmitted to the portable digital device relating to

a financial transaction performed using the self-service terminal (column 4, line 50 – column 5, line 2). Note that in the reference, a user with a portable digital device (PDD) makes a request for service from a self-service terminal. The self-service terminal responds with information about the transaction that can include transaction ID and information about the terminal.

- b. A digital data transfer device which transfers data between the port and a digital data network (figure 9). The self-service terminal has the capability of making requests and sending data over the Internet.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (USPN 6,282,656) in view of Slotznick (USPN 6,108,640).

13. Regarding claim 8, Wang (USPN 6,282,656) shows the use of a self-service terminal and PDD for a financial transaction (column 4, line 50 – column 5, line 2).

Although the system disclosed by Wang (USPN 6,282,656) shows substantial features of the claimed invention, it fails to disclose means wherein the terminal is operable to interact with the portable digital device such that the terminal is operable to read personal information from the portable digital device, and thereby build a profile of the customer utilized while conducting the transaction.

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Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Wang (USPN 6,282,656), as evidenced by Slotznick (USPN 6,108,640).

In an analogous art, Slotznick (USPN 6,108,640) discloses a system for interaction of a portable digital device with a digital network including self service terminals comprising means wherein the terminal is operable to interact with the personal digital device such that the terminal is operable to read personal information from the portable digital device, and thereby build a profile of the customer (column 26, lines 30-33). Note that the reference collects information as to the access by customers and uses this information in profiling.

Given the teaching of Slotznick (USPN 6,108,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Wang (USPN 6,282,656) by employing the obtaining of customer information during use to build or add on to an existing customer profile. This would allow the system to more quickly present user preferences and to keep statistical information as to usage in different locations. This specialized information will benefit the system by allowing for targeted advertising and faster service for customers.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (USPN 6,282,656) in view of Kolling et al. (USPN 5,963,925).

15. Regarding claim 18, although the system disclosed by Wang (USPN 6,282,656) (as applied to claim 5) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the financial transaction data includes an electronic statement.



Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Wang (USPN 6,282,656), as evidenced by Kolling et al. (USPN 5,963,925).

In an analogous art, Kolling et al. (USPN 5,963,925) discloses a system for electronically presenting financial transaction information to a personal digital device wherein the financial transaction data includes an electronic statement (column 7, lines 25-34; column 30, lines 37-55). Note that in the reference, statements are sent and presented electronically to a user's personal digital device.

Given the teaching of Kolling et al. (USPN 5,963,925), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Wang (USPN 6,282,656) by employing the use of an electronic financial statement. The users of a financial data kiosk will expect some sort of receipt to prove their activity. This electronic statement benefits the system by allowing the user to automatically update records in the personal digital device and store for download to a personal computer later.

16. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (USPN 6,282,656) in view of Aldridge et al. (USPN 6,047,047).

17. Regarding claim 19, although the system disclosed by Wang (USPN 6,282,656) (as applied to claim 5) shows substantial features of the claimed invention, it fails to disclose means wherein the terminal transfers received email messages to the portable digital device.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Wang (USPN 6,282,656), as evidenced by Aldridge et al. (USPN 6,047,047).

In an analogous art, Aldridge et al. (USPN 6,047,047) discloses the receipt of email messages without the use of a home computer. The terminal is stand-alone and comprises means wherein the terminal transfers received email messages to the portable digital device (column 4, lines 3-6, 32-36, 54-57). Note that in the reference, the PDA sends and receives email through a terminal that can be a phone. An Infrared or RF link can be used. The messages are sent via the Internet, as any other email would be.

Given the teaching of Aldridge et al. (USPN 6,047,047), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Wang (USPN 6,282,656) by employing the sending and receiving of emails via the financial services kiosk. Kiosks for Internet usage and email are popular. By combining the functions of banking with email communications, a user may perform several needed functions at the same point of service. This benefits the system by saving user time as well as giving the opportunity to charge the user for usage directly from a financial account since he/she has been validated in the financial transaction.

18. Regarding claim 20, although the system disclosed by Wang (USPN 6,282,656) (as applied to claim 5) shows substantial features of the claimed invention, it fails to disclose means wherein the terminal receives email messages from the portable digital device and transfers the email messages to the digital data network for delivery.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Wang (USPN 6,282,656), as evidenced by Aldridge et al. (USPN 6,047,047).

In an analogous art, Aldridge et al. (USPN 6,047,047) discloses the receipt of email messages without the use of a home computer. The terminal is stand-alone and comprises means wherein the terminal transfers received email messages to the portable digital device (column 4, lines 3-6, 32-36, 54-57). Note that in the reference, the PDA sends and receives email through a terminal that can be a phone. An Infrared or RF link can be used. The messages are sent via the Internet, as any other email would be.

Given the teaching of Aldridge et al. (USPN 6,047,047), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Wang (USPN 6,282,656) by employing the sending and receiving of emails via the financial services kiosk. Kiosks for Internet usage and email are popular. By combining the functions of banking with email communications, a user may perform several needed functions at the same point of service. This benefits the system by saving user time as well as giving the opportunity to charge the user for usage directly from a financial account since he/she has been validated in the financial transaction.

19. Regarding claim 21, Wang (USPN 6,282,656) teaches all the limitations as applied to claim 20. He further teaches means wherein financial data is provided to the network via the terminal (column 4, line 50 – column 5, line 2). Note that in the reference, the Internet is used for the transfer of validation information and information about the transaction from the terminal.

Although the system disclosed by Wang (USPN 6,282,656) shows substantial features of the claimed invention, it fails to disclose means wherein email data is also sent via the terminal to the network.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Wang (USPN 6,282,656), as evidenced by Aldridge et al. (USPN 6,047,047).

In an analogous art, Aldridge et al. (USPN 6,047,047) discloses a system wherein a self-service terminal sends emails from a PDA onto a network (column 4, lines 3-6, 32-36, 54-57).

Given the teaching of Aldridge et al. (USPN 6,047,047), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Wang (USPN 6,282,656) by employing the sending and receiving of emails via the financial services kiosk. Kiosks for Internet usage and email are popular. By combining the functions of banking with email communications, a user may perform several needed functions at the same point of service. This benefits the system by saving user time as well as giving the opportunity to charge the user for usage directly from a financial account since he/she has been validated in the financial transaction.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-9242 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Kevin Parton  
Examiner  
Art Unit 2153

ksp  
January 9, 2003

  
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